

REMARKS

This Response is submitted in reply to the Office Action dated January 19, 2006. Claims 1 to 74 are pending in the application.

A Request for Continued Examination is submitted herewith. A Supplemental Information Disclosure Statement is submitted herewith. A check in the amount of \$790.00 is submitted herewith to cover the cost of the RCE. Please charge Deposit Account No. 02-1818 for any insufficiency of payment or credit any overpayment.

The Office Action rejected:

- (a) Claims 1-46, 49-51 and 54-74 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,823,874 to Adams ("Adams") in view of U.S. Patent No. 1,978,395 to Groetchen ("Groetchen");
- (b) Claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Groetchen in further view of U.S. Patent No. 6,086,066 to Takeuchi et al. ("Takeuchi"); and
- (c) Claims 52 and 53 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Groetchen in further view of U.S. Patent No. 4,326,351 to Heywood et al. ("Heywood").

Applicants respectfully disagree with and traverse these rejections.

Applicants believe there is insufficient motivation to combine Adams and Groetchen. Motivation to combine cannot come from the invention itself, and to prevent such hindsight-based obviousness analysis, "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references" is required. In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D 1614, 1617 (Fed. Cir. 1999). The motivation may be found explicitly or implicitly in (1) the prior art references, (2) the nature of the problem to be solved, or (3) the knowledge of those of ordinary skill in the art "that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field." Pro-Mold & Tool Co. v. Great Lakes

Plastics, Inc., 75 F.3d 1568, 1572, 37 U.S.P.Q.2D 1626, 1630 (Fed. Cir. 1996). See also M.P.E.P. § 2143.01. Further, a finding of motivation to combine must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2D 1430, 1433 (Fed. Cir. 2002). See also M.P.E.P. § 2143.01. Even if the references relied upon are known in the art and combination of the references would be "well within the ordinary skill of the art at the time the claimed invention was made," a rejection based on obviousness is still improper without some objective reason to combine the teachings of the references. M.P.E.P. § 2143.01.

It is respectfully submitted that motivation to combine cannot come from the nature of the problem to be solved because Adams and Groetchen solve substantially different problems. Adams solves the problem of providing a payout indicator which is discernible by a player and/or other observers, wherein the payout indicator is clearly visible to a player as it moves towards a winning position. Col. 2, Lines 40-58; Col. 3, Lines 54-60. Groetchen solves a different problem. Groetchen solves the problem of providing a vending machine which also has a game to attract a purchaser, wherein the game is played when an item is vended. Page 1, Lines 1-7; Page 2, Lines 22-24. It is respectfully submitted that there is no evidence that one of ordinary skill in the art attempting to solve the problem of Adams would be motivated by the nature of the problem to combine Adams with solutions to the problem of Groetchen, and vice versa.

Motivation to make this combination also cannot come from the knowledge of those of ordinary skill in the art that certain references, or disclosures in the references, are known to be of special interest or importance in the particular field. There is no evidence that the cited references or disclosures in the references are known to those of ordinary skill in the art to be of special interest or importance in the field of the application.

Consequently, for the Office Action's combination to be proper, motivation to combine would have to be found explicitly or implicitly in the prior art references. The Office Action states that the device of Groetchen is a slot machine device. Applicants respectfully disagree. Groetchen appears to operate as a vending machine. The game described by Groetchen has a plurality of reels; however, Groetchen does not disclose or suggest that a prize is provided to the user dependent upon the outcome of any

game played using that plurality of reels. To the contrary, the item disclosed as being provided to the user is the vended article dispensed on each use of the vending machine. Page 1, Line 92 – Page 2, Line 27. Further, Groetchen discloses that the game portion of the device is rendered inoperative if the vending device is out of articles to vend. Page 2, Lines 98-139. It is therefore respectfully submitted that it is improper to combine the gaming device of Adams with the vending machine of Groetchen. However, even assuming gaming device of Adams and the vending machine of Groetchen can be combined, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Neither Adams nor Groetchen suggests the desirability of the combination.

As discussed above, Adams discloses discernible indicia of a mechanical bonus indicator which is clearly visible as it approaches a winning position. In contrast, Groetchen discloses one or more windows which are covered until a cover is retracted. It is respectfully submitted that the concealing cover of Groetchen is substantially different from a bonus indicator that is clearly visible as it approaches a winning position. It is therefore respectfully submitted that the discernible indicia of a mechanical bonus indicator of Adams would not motivate one of ordinary skill in the art to combine Adams and Groetchen.

It is respectfully submitted that no objective evidence showing either implicit or explicit motivation to combine Adams and Groetchen has been presented. As a result, the conclusion that “in view of Groetchen, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Adams, wherein a secondary display provides bonus payout, to add a secondary display wherein moveable members selectively masks the secondary display, the device selects a symbol from the plurality of symbols; displays the symbol on the secondary display; and actuates the moveable member to move to reveal the symbol by actuating the movable member” is not supported by objective evidence.

For at least these reasons, Applicants respectfully submit that the combination of Adams and Groetchen is inappropriate, and therefore, rejections based on the combination are overcome.

Takeuchi relates to a gaming device having a vibrating member which is revealed after a jackpot occurs. It is respectfully submitted that Takeuchi does not provide motivation to combine Adams and Groetchen.

Heywood relates to a display device for a poker or fruit machine having a closed loop of a flexible strip of material. It is respectfully submitted that Heywood does not provide motivation to combine Adams and Groetchen.

It is therefore respectfully submitted that independent Claims 1, 18, 32, 44, 57-58, 65 and 72 and Claims 2-17 that depend from Claim 1, Claims 19-31 that depend from Claim 18, Claims 33-43 that depend from Claim 32, Claims 45-56 that depend from Claim 44, Claims 59-64 that depend from Claim 58, Claims 66-71 that depend from Claim 65 and Claims 73-74 that depend from Claim 72 are each patentably distinguished over Adams in view of Groetchen and are in condition for allowance.

For similar reasons, it is respectfully submitted that independent Claims 1, 18, 32, 44, 57-58, 65 and 72 and Claims 2-17 that depend from Claim 1, Claims 19-31 that depend from Claim 18, Claims 33-43 that depend from Claim 32, Claims 45-56 that depend from Claim 44, Claims 59-64 that depend from Claim 58, Claims 66-71 that depend from Claim 65 and Claims 73-74 that depend from Claim 72 are each patentably distinguished over Adams in view of Groetchen in further view of Takeuchi or Heywood and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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